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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			JANVIER, JEAN D	
		ART UNIT	PAPER NUMBER	
		3622		

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Appln(s) _____ ROCHON ET AL.
	Examiner Jean D Janvier	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 July 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5,7-20 and 22-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5, 7-20 and 22-37 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)      4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      6) Other: \_\_\_\_\_

### **Response To Amendments**

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on March 14, 2002 has been entered and a Non-Final Office Action is submitted below.

### **DETAILED ACTION**

#### ***Status of the case***

Claims 1-37 were originally presented. Claims 6 and 21 were canceled. Hence, claims 1-5, 7-20 and 22-37 are currently pending in the Instant Application.

#### ***Claim Objections***

Claims 1, 16 and 31 (including respective subsequent dependent claims) are objected to because of the following informalities:

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Regarding claims 1, 16 and 31 (including respective subsequent dependent claims), the new claim limitations "transmitting a solicitation for feedback regarding said product from said main computer over said computer network to said network address for said user's computer" should be replaced with --transmitting a solicitation for feedback regarding **said sample** of said product from said main computer over said computer network to said network address for said user's computer-- since the product associated with the sample has not yet been acquired or purchased by the user. That is why the sample is provided to the user, in the first place, so that the user can be encouraged to buy the product associated with the sample subsequent to successfully using the sample. Here, soliciting feedback on a product that has not been acquired yet is premature, as would have concluded one having ordinary skill in the art. Hence, these claims will be prosecuted accordingly.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 recites the limitation "...said samples...". There is insufficient antecedent basis for this limitation in the claim. For examination purpose, the Examiner assumes that the Applicant meant to refer to ----said sample----, as recited in parent claim 16.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7-8, 10, 12-20, 22-23, 25 and 27-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Scroggie et al, WO 97/23838.

As per claims 1-5, 7-8, 10 and 12-15, Scroggie et al teach a method comprising the steps of:

1.

Transmitting a signal via **Log-in Page 16 of fig.1** prompting a user **10** to provide profile data, **upon completing Form 82 of fig.2**, including identification of the user from a main computer **or a Server or a Computer at a central site** over computer network or **Internet 304 of fig.13** to a network address **or IP address** for the user's computer **302 of fig.13** (See abstract-page 2 lines 1-7 and page 10 lines 5-17);

Transmitting a manufacturer's sample offer **154 of fig.5** (page 12 lines 11-26 and page 13 lines 2-5) **or other variety of offers stored in storage device or Hard Disk 306 of fig.13 by**

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**manufacturers**, from said main computer or Server 300 of fig.13 over said computer network or Internet 304 of fig.13 to said network address or IP address for said user's computer 302 of fig.13 (page 18 line 20 to page 19 line 12) if said user's profile data such as Zip code, preferences and buying pattern meet user profile criteria associated with a manufacturer's sample offer for a sample 154 of fig.5 (page 4 lines 3-10 and page 21 lines 4-21) of a product; and

Generating instructions for providing said sample 154 of fig.5 of said product or other variety of offers to said user 10 of fig.1 if said main computer or Server 300 of fig.13 receives a signal transmitted over said computer network 304 of fig.13 indicating said user accepts said manufacturer's sample offer (fig.14 and page 19 line 15 to page 20 line 8).

Transmitting a solicitation for feedback via the presentation of a questionnaire (or presenting a questionnaire about the offer or a product sample associated with the product offer), by sending an e-mail or prompting user 10 to provide an evaluation or answering a questionnaire associated with the offer or a sample of the product, regarding said sample of said product from said main computer or Server or Web Site over said computer network or Internet 304 to said network address or IP address for said user's computer 510 (page 12: 11-27).

2. The method further comprising the step of:

Determining, upon comparing user's profile data with a manufacturer's profile data to qualify a user for an incentive or product sample offer 154 of fig.5, if said user's profile data or demographic data meet said user profile criteria associated with said manufacturer's

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sample offer, or other variety of offers, for a sample of said product (Determining if the user lives in a Zip code where a retailer selling the manufacturer's product is located- page 21 lines 14-21).

3. The method further comprising the step of:

Determining if said main computer or Web Server or Web Site 508 of fig.15 receives, subsequent to sending an e-mail to user 10 regarding the manufacturer's weekly offers 520 such a product sample 154, said signal or response transmitted over said computer network or Internet 304 indicating said user accepts said manufacturer's sample offer or weekly offers upon reading the content of e-mail and accepting the weekly offers or sample 154 from the manufacturers by sending an e-mail to the manufacturers via Internet 304 (fig.15- p.19 lines 15-25).

4. (Amended) The method further comprising the step of:

Determining, upon tracking user 10 transaction on-line or in the store via user 10 identification such as credit card, debit card or magnetic encoded check or any other acceptable identification, if said user purchases a product for which said instructions for providing said sample of said product or a coupon on the product are generated (As herein supported, the user may receive more than one incentives, including a coupon, a sample, on a product described in an offer. Upon redeeming, for example, the coupon related to the product, the user purchases the product at a discounted price and the system is operable to determine in real-time that the identified user has indeed used the coupon by buying the product described in

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the offer. In other, the system has determined that the user has indeed bought the product associated with the coupon and associated with the sample-p. 12: 10-27; p.19: 15-25).

5. Wherein said transmitting said manufacturer's sample offer comprises the step of:

Storing said profile data in a consumer database 506 of fig.15.

7. Wherein said step of transmitting a signal comprises:

Transmitting a signal prompting said user to provide said user's postal mailing address, **including a Zip code** (p.14 line 24 to p.15 line 2).

8. The method further comprising the step of:

Transmitting a record containing the postal mailing address of said user from said main computer to a network address for a third party **or Fulfillment House 158 of fig. 5.or a clearinghouse for processing the mailing of the sample or product sample** (It is anticipated here that an individual or a fulfillment or clearinghouse company or a third party has to process the mailing of the sample to the user subsequent to receiving the mailing address of the user-12: 29 to p.13: 5).

10. The method further comprising the step of:

Mailing said sample to a postal address for said user (see abstract and p.12 line 25).

12. Wherein said step of transmitting said manufacturer's sample offer comprises the step of:

Sending e-mail, **which contains a token attachment or an advisory message**, over the computer network or **Internet 304** to said user 10 (see figs 13, 14 and 15; p. 18: 21 to p. 19: 28).

13. The method further comprising the step of:

Storing said profile data and purchase data regarding a user's purchase in association with a unique identifier uniquely identifying said user in a consumer database **506 of fig.15, integrated with Consumer Purchase History database 502**, (p.20 lines 17-24).

14. The method further comprising the step of:

Determining consumer conversion based at least in part on said purchase data stored in said consumer database **506 of fig.15, integrated with Consumer Purchase History database 502, upon tracking user 10 transaction on-line or in the store via user 10 identification such as credit card, debit card or magnetic check or any other acceptable identification** (determining if the user has purchased a product associated with a coupon, recipe or a sample- p.19 lines 15-25; p. 23: 3-16).

15. The method further comprising the step of:

Transmitting said manufacturer's sample **154 offer or Weekly offers 520 from Manufacturers 518** from said main computer or **Web Site 508 or Server 300** over said computer network or **Internet 304** to said network address or IP address for said user's computer 510 or 302 only if said user's profile data (**such a ZIP code**) meet said user profile criteria **stored in database 506** (originally determined and said purchase history data meet

purchase history criteria associated with said manufacturer's sample offer for said sample of said product **or any other incentive** (Broadly interpreted, the user receives focused or targeted and more substantial incentives, such as coupons, product samples, etc., if the user not only lives in a pre-qualified ZIP code, but also the purchase history of the user is constantly tracked or monitored when the user is identified during transactions at participating POSes and those targeted incentives, including coupons, product samples, supermarket specials, etc., are transmitted to the user via e-mail or when the user next logs into the system- fig.15- p.19: 15 to p.23: 22).

As per claims 16-20, 22-23, 25 and 27-37, Scroggie et al disclose a system comprising:

16. (Amended) A computer network system, comprising:

A main computer (300) of fig.13 or (508) of fig.15, said main computer configured:

To transmit a signal via **Log-in Page 16 of fig.1** prompting a user 10 to provide profile data, **upon completing Form 82 of fig.2**, including identification of the user from a main computer **or a Server or a Computer at a central site** over computer network or **Internet 304 of fig.13** to a network address **or IP address** for the user's computer **302 of fig.13** (See abstract-p.2 lines 1-7 and p.10 lines 5-17);

To transmit a manufacturer's sample offer**154 of fig.5 (p. 12 lines 11-26 and p.13 lines 2-5) or other variety of offers stored in storage device or Hard Disk 306 of fig.13 by manufacturers**, from said main computer **or Server 300 of fig.13** over said computer network **or Internet 304 of fig.13** to said network address **or IP address** for said user's computer **302 of**

**fig.13** (p.18 line 24 to p.19 line 12) if said user's profile data **such as Zip code, preferences and buying pattern** meet user profile criteria associated with a manufacturer's sample offer for a sample **154 of fig.5** (p.4 lines 3-10 and p.21 lines 4-21) of a product; and

To generate instructions for providing said sample **154 of fig.5** of said product **or other variety of offers** to said user 10 of fig.1 if said main computer **or Server 300 of fig.13** receives a signal transmitted over said computer network **304 of fig.13** indicating said user accepts said manufacturer's sample offer (fig.14 and p.19 line 15 to p.20 line 8)

To Transmit a solicitation for feedback **via the presentation of a questionnaire** (or presenting a questionnaire about the offer or a product sample associated with the product offer), **by sending an e-mail or prompting user 10 to provide an evaluation or answering a questionnaire associated with the offer or a sample of the product**, regarding said sample of said product from said main computer **or Server or Web Site** over said computer network **or Internet 304** to said network address or **IP address** for said user's computer 510 (page 12: 11-27).

Claims 17-20, 22-23, 25 and 27-30 recite limitations already addressed in claims 2-5, 7, 8, 10 and 12-15 respectively and therefore, these limitations of claims 17-20, 22-23, 25 and 27-30 are rejected under a similar rationale as respectively applied to claims 2-5, 7, 8, 10 and 12-15 above.

As per claim 31, Scroggie et al teach -

**A computer program or any other custom-built package written by experienced computer programmers encoded on a readable medium or Hard Disk to perform, when executed on a computer or main computer 300 or 508, the following tasks as anticipated by Scroggie et al:**

Transmitting a signal prompting a user to provide profile data including identification of the user from a main computer over a computer network to a network address for the user's computer;

Transmitting a manufacturer's sample/Offer from said main computer over said computer network to said network address for said user's computer if said user's profile data meets user profile criteria associated with manufacturer's sample offer for a sample of a product; and

Generating instructions for providing said sample of said product to said user if said main computer receives a signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer.

To Transmit a solicitation for feedback via the presentation of a questionnaire (or presenting a questionnaire about the offer or a product sample associated with the product offer), by sending an e-mail or prompting user 10 to provide an evaluation or answering a questionnaire associated with the offer or a sample of the product, regarding said sample of said product from said main computer or Server or Web Site over said computer network or Internet 304 to said network address or IP address for said user's computer 510 (page 12: 11-27).

(See related discussions on claims 1 and 16).

Claims 32-34. Wherein said means for performing said steps of transmitting a manufacturer's sample offer for a sample of a product comprises means for transmitting a manufacturer's sample for a sample of a packaged good product (broadly interpreted, mailing the sample implies that the sample is a sample for a packaged good- page 12: 11-27).

Claims 35-37. Wherein said means for performing said steps of generating instructions for providing said sample of said product to said user comprises means for generating instructions for packaging and shipping the sample of the product (broadly interpreted, mailing the sample implies that the sample is a sample for a packaged good that must be shipped out- page 12: 11-27).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9,11, 24, 26 and 1-5, 7-8, 10, 12-20, 22-23, 25 and 27-37 are rejected under 35 U.S.C. 103(a) as being obvious over Scroggie, WO 97/23838.

As per claims 9, 11, 24 and 26, although Scroggie explicitly supports mailing incentives, including coupons, product samples, etc., to a user or electronically transmitting the incentive or coupon data to a store POS designated by the user who receives a token or an advisory message used to redeem the incentives or coupons at the designated POS, Scroggie does not expressly disclose mailing a coupon for a full price discount of the said sample to the user (or simply mailing a pass to the user to allow him to pick up the free sample), nor does he teach transmitting an electronic version of the said coupon (pass) to a POS terminal where the user can pick the said sample at no cost.

However, sending a pass (or a full discount coupon or 100% discount coupon) to a user allowing him to pick a free gift or a promotional item (a sample) at a local retailer's or at a warehouse or to gain free access or free entry at a scheduled event, or electronically transmitting data related to the pass to a POS terminal and providing the user with a code to thereby enable him to claim the free gift or promotion item (sample) or to gain free access at the scheduled event is an old and well established business scheme practiced in the industry for many years. For example, a listener listening to a local radio station wins a free ticket (free pass or 100%

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discount) for a scheduled event (game or show) or receives a free gift (promotional item or a free meal at a local restaurant) for being, for example, the one-hundredth caller, or for correctly answering a question broadcast on the station. Further, the caller or the winner or listener can stop by the station to pick the free ticket or free pass (100% discount) or the free ticket can be mailed or e-mailed to the caller. Additionally, data related to the free ticket or free pass and the caller's identification maybe forwarded (electronically) to the scheduled event or restaurant POS, subsequent to receiving in real-time the caller's personal information by the local radio station. Finally, the caller can go to the scheduled event or the restaurant and take advantage of the free admittance (free entry) or the free meal upon properly identifying himself at the scheduled event or restaurant POS using, for example, a driver's license or a credit/debit card bearing at least the caller's name.

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure into the system of Scroggie so as to mail a free pass or an advisory note (coupon for a full price discount of the said sample) to a user to allow him to pick up a free sample at a local retailer's or warehouse or to transmit an electronic version of the said free pass (coupon) to the local retailer's or warehouse POS terminal where the user can pick the said sample at no cost upon presenting a received token or properly identifying himself using an acceptable identification, such as a driver's license, thereby encouraging the user to test or use a free sample of a product by providing the user with a free pass to pick the free sample at the local retailer's POS, where the user can further engage in a transaction while receiving the free sample, wherein the user may eventually purchase or acquire the product associated with the free

sample subsequent to successfully trying or using the free sample or at least provide some comments regarding the used sample, wherein these comments will be used to fine tune the final product related to the tested sample, as known in the art.

As per claims 1, 16, 31, 2-5, 7-8, 10 and 12-15, Scroggie et al teach a method comprising the steps of:

1.

Transmitting a signal via **Log-in Page 16 of fig.1** prompting a user **10** to provide profile data, **upon completing Form 82 of fig.2**, including identification of the user from a main computer **or a Server or a Computer at a central site** over computer network or **Internet 304 of fig.13** to a network address **or IP address** for the user's computer **302 of fig.13** (See abstract-page 2 lines 1-7 and page 10 lines 5-17);

Transmitting a manufacturer's sample offer**154 of fig.5** (page 12 lines 11-26 and page 13 lines 2-5) **or other variety of offers stored in storage device or Hard Disk 306 of fig.13 by manufacturers**, from said main computer **or Server 300 of fig.13** over said computer network **or Internet 304 of fig.13** to said network address **or IP address** for said user's computer **302 of fig.13** (page 18 line 20 to page 19 line 12) if said user's profile data **such as Zip code, preferences and buying pattern** meet user profile criteria associated with a manufacturer's sample offer for a sample **154 of fig.5** (page 4 lines 3-10 and page 21 lines 4-21) of a product; and

Generating instructions for providing said sample **154 of fig.5** of said product **or other variety of offers** to said user **10** of fig.1 if said main computer or **Server 300 of fig.13** receives a signal transmitted over said computer network **304 of fig.13** indicating said user accepts said manufacturer's sample offer (fig.14 and page 19 line 15 to page 20 line 8).

Transmitting a solicitation for feedback **via the presentation of a questionnaire** (or presenting a questionnaire about the offer or a product sample associated with the product offer), **by sending an e-mail or prompting user 10 to provide an evaluation or answering a questionnaire associated with the offer or a sample of the product**, regarding said sample of said product from said main computer or **Server or Web Site** over said computer network or **Internet 304** to said network address or **IP address** for said user's computer **510** (page 12: 11-27).

16. (Amended) A computer network system, comprising:

A main computer (300) of fig.13 or (508) of fig.15, said main computer configured:

To transmit a signal **via Log-in Page 16 of fig.1** prompting a user **10** to provide profile data, **upon completing Form 82 of fig.2**, including identification of the user from a main computer or a **Server or a Computer at a central site** over computer network or **Internet 304 of fig.13** to a network address or **IP address** for the user's computer **302 of fig.13** (See abstract-p.2 lines 1-7 and p.10 lines 5-17);

To transmit a manufacturer's sample offer **154 of fig.5** (p. 12 lines 11-26 and p.13 lines 2-5) **or other variety of offers stored in storage device or Hard Disk 306 of fig.13** by **manufacturers**, from said main computer or **Server 300 of fig.13** over said computer network

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**or Internet 304 of fig.13** to said network address or **IP address** for said user's computer **302 of fig.13** (p.18 line 24 to p.19 line 12) if said user's profile data such as **Zip code, preferences and buying pattern** meet user profile criteria associated with a manufacturer's sample offer for a sample **154 of fig.5** (p.4 lines 3-10 and p.21 lines 4-21) of a product; and

To generate instructions for providing said sample **154 of fig.5** of said product **or other variety of offers** to said user 10 of fig.1 if said main computer or **Server 300 of fig.13** receives a signal transmitted over said computer network **304 of fig.13** indicating said user accepts said manufacturer's sample offer (fig.14 and p.19 line 15 to p.20 line 8)

To Transmit a solicitation for feedback via **the presentation of a questionnaire** (or presenting a questionnaire about the offer or a product sample associated with the product offer), **by sending an e-mail or prompting user 10 to provide an evaluation or answering a questionnaire associated with the offer or a sample of the product**, regarding said sample of said product from said main computer or **Server or Web Site** over said computer network or **Internet 304** to said network address or **IP address** for said user's computer 510 (page 12: 11-27).

31.

**A computer program or any other custom-built package written by experienced computer programmers encoded on a readable medium or Hard Disk to perform, when executed on a computer or main computer 300 or 508, the following tasks as expected by Scroggie et al:**

Transmitting a signal prompting a user to provide profile data including identification of the user from a main computer over a computer network to a network address for the user's computer;

Transmitting a manufacturer's sample/Offer from said main computer over said computer network to said network address for said user's computer if said user's profile data meets user profile criteria associated with manufacturer's sample offer for a sample of a product; and

Generating instructions for providing said sample of said product to said user if said main computer receives a signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer.

To Transmit a solicitation for feedback via the presentation of a questionnaire (or presenting a questionnaire about the offer or a product sample associated with the product offer), by sending an e-mail or prompting user 10 to provide an evaluation or answering a questionnaire associated with the offer or a sample of the product, regarding said sample of said product from said main computer or Server or Web Site over said computer network or Internet 304 to said network address or IP address for said user's computer 510 (page 12: 11-27).

(See related discussions on claims 1 and 16).

As per claims 1, 16 and 31, although Scroggie explicitly supports presenting a questionnaire associated with an offer to a user (page 12: 10-27), he does not expressly disclose soliciting feedback from the user regarding a free sample associated with a product or regarding the product itself after the user has purchased and consumed the said product.

However, soliciting feedback from a customer who has tested a product sample or consumed a product is old and well established in the industry. For example, Software companies, like Microsoft Corp., will distribute free samples or different Beta versions (Beta1, Beta2,,,) of upcoming Software to professionals or users in the field so that the users can test the Software before the final release. During the distribution of the different Beta versions (pre-releases) of the Software, the users provide feedback or comments regarding the different Beta versions (samples) of the Software, after using or testing the samples, to the Software companies, which use the feedback to correct bugs or to simply fine tune the final release of the Software. This Beta testing stage, following an internal Alpha testing, is critical and widely used in developing Software. Additionally, product manufacturers usually require consumers to register an item purchased from a vendor using a registration form that is included inside the product packaging. This type of registration form contains fields such as name, home & work telephone numbers, e-mail address, home & work addresses, occupation, gender, age, product serial number, place & date of purchase, comments and also the reason for buying the product. Using the comments field, for instance, the user can provide feedback regarding the purchased item or product. Finally, a representative from the manufacturer can contact the user to solicit feedback or comments concerning the product after the user has a chance to use or consume the said product or item.

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure into the system of Scroggie so as to provide a free sample related to a product to a user and subsequent request or solicit feedback or comments

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from the user after the user has consumed or tested the free sample or eventually the final product itself upon acquiring or purchasing the said product, thereby encouraging the user to test or use a free sample associated with a product and solicit feedback or comments from the user, subsequent to successfully trying or using the free product sample, wherein these comments will be used to fine tune the final product related to the tested sample before its release and wherein the user eventually purchases or acquires the product associated with the free sample and provides via a registration form corresponding to the purchased product further comments or feedback after consuming the purchased product and wherein these comments imprinted in the product registration form are utilized to update or enhance future version or new releases of the product.

2. The method further comprising the step of:

**Determining, upon comparing user's profile data with a manufacturer's profile data to qualify a user for an incentive or product sample offer 154 of fig.5, if said user's profile data or demographic data meet said user profile criteria associated with said manufacturer's sample offer, or other variety of offers, for a sample of said product (Determining if the user lives in a Zip code where a retailer selling the manufacturer's product is located- page 21 lines 14-21).**

3. The method further comprising the step of:

**Determining if said main computer or Web Server or Web Site 508 of fig.15 receives, subsequent to sending an e-mail to user 10 regarding the manufacturer's weekly offers 520**

**such a product sample 154, said signal or response transmitted over said computer network or Internet 304 indicating said user accepts said manufacturer's sample offer or weekly offers upon reading the content of e-mail and accepting the weekly offers or sample 154 from the manufacturers by sending an e-mail to the manufacturers via Internet 304 (fig.15- p.19 lines 15-25).**

4. (Amended) The method further comprising the step of:

Determining, upon tracking user 10 transaction on-line or in the store via user 10 identification such as credit card, debit card or magnetic encoded check or any other acceptable identification, if said user purchases a product for which said instructions for providing said sample of said product or a coupon on the product are generated (As herein supported, the user may receive more than one incentives, including a coupon, a sample, on a product described in an offer. Upon redeeming, for example, the coupon related to the product, the user purchases the product at a discounted price and the system is operable to determine in real-time that the identified user has indeed used the coupon by buying the product described in the offer. In other, the system has determined that the user has indeed bought the product associated with the coupon and associated with the sample-p. 12: 10-27; p.19: 15-25).

5. Wherein said transmitting said manufacturer's sample offer comprises the step of:

Storing said profile data in a consumer database 506 of fig.15.

7. Wherein said step of transmitting a signal comprises:

Transmitting a signal prompting said user to provide said user's postal mailing address, **including a Zip code** (p.14 line 24 to p.15 line 2).

8. The method further comprising the step of:

Transmitting a record containing the postal mailing address of said user from said main computer to a network address for a third party **or Fulfillment House 158 of fig. 5.or a clearinghouse for processing the mailing of the sample or product sample** (It is expected here that an individual or a fulfillment or clearinghouse company or a third party has to process the mailing of the sample to the user subsequent to receiving the mailing address of the user-12: 29 to p.13: 5).

10. The method further comprising the step of:

Mailing said sample to a postal address for said user (see abstract and p.12 line 25).

12. Wherein said step of transmitting said manufacturer's sample offer comprises the step of:  
Sending e-mail, **which contains a token attachment or an advisory message**, over the computer network or **Internet 304** to said user 10 (see figs 13, 14 and 15; p. 18: 21 to p. 19: 28).

13. The method further comprising the step of:

Storing said profile data and purchase data regarding a user's purchase in association with a unique identifier uniquely identifying said user in a consumer database **506 of fig.15, integrated with Consumer Purchase History database 502**, (p.20 lines 17-24).

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14. The method further comprising the step of:

Determining consumer conversion based at least in part on said purchase data stored in said consumer database **506 of fig.15, integrated with Consumer Purchase History database 502, upon tracking user 10 transaction on-line or in the store via user 10 identification such as credit card, debit card or magnetic check or any other acceptable identification** (determining if the user has purchased a product associated with a coupon, recipe or a sample- p.19 lines 15-25; p. 23: 3-16).

15. The method further comprising the step of:

Transmitting said manufacturer's sample **154 offer or Weekly offers 520 from Manufacturers 518** from said main computer or Web Site **508 or Server 300** over said computer network or Internet **304** to said network address or IP address for said user's computer **510 or 302** only if said user's profile data (**such a ZIP code**) meet said user profile criteria **stored in database 506** (originally determined and said purchase history data meet purchase history criteria associated with said manufacturer's sample offer for said sample of said product **or any other incentive** (Broadly interpreted, the user receives focused or targeted and more substantial incentives, such as coupons, product samples, etc., if the user not only lives in a pre-qualified ZIP code, but also the purchase history of the user is constantly tracked or monitored when the user is identified during transactions at participating POSes and those targeted incentives, including coupons, product samples, supermarket specials, etc., are transmitted to the user via e-mail or when the user next logs into the system- fig.15- p.19: 15 to p.23: 22).

As per claims 17-20, 22-23, 25, 27-30 and 32-37, Scroggie et al disclose a system comprising:

Claims 17-20, 22-23, 25 and 27-30 recite limitations already addressed in claims 2-5, 7, 8, 10 and 12-15 respectively and therefore, these limitations of claims 17-20, 22-23, 25 and 27-30 are rejected under a similar rationale as respectively applied to claims 2-5, 7, 8, 10 and 12-15 above.

Claims 32-34. Wherein said means for performing said steps of transmitting a manufacturer's sample offer for a sample of a product comprises means for transmitting a manufacturer's sample for a sample of a packaged good product (broadly interpreted, mailing the sample implies that the sample is a sample for a packaged good- page 12: 11-27).

Claims 35-37. Wherein said means for performing said steps of generating instructions for providing said sample of said product to said user comprises means for generating instructions for packaging and shipping the sample of the product (broadly interpreted, mailing the sample implies that the sample is a sample for a packaged good that must be shipped out- page 12: 11-27).

#### **Response To Arguments**

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The Applicant's arguments are based on the amended claims and are fully addressed in the above Office Action. Further, it appears that the Applicant argues that the prior art does not disclose **soliciting feedback from the user regarding the sample**. However, such limitations are not claimed. In fact, the Examiner does not read limitations from the specification into the claimed invention, although the Examiner reads the claims in view of the specification. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### Conclusion

Although www.freesamples.com was not used in this Office Action, it was highly considered as relevant prior Art. Applicants are further directed to consult this reference.

WWW.freesamples.com- the claimed invention was disclosed in freesamples.com where a user could log into the site and select a particular free sample of a product, which can be downloaded or mailed to the user's mailing address, upon registering with the web site.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):  
After Final- 703-872-9327

Application/Control Number: 09/418,509  
Art Unit: 3622

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Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ

01/07/04

*Tanner Jean Davis*